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10/552,010	06/05/2006	Mitsuhiro Kasai	512.45517X00	6264

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EXAMINER	
LENIHAN, JEFFREY S	
ART UNIT	PAPER NUMBER
1796	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/552,010	KASAI ET AL.	
	Examiner	Art Unit	
	Jeffrey Lenihan	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11/07/2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6* is/are rejected.

7)☐ Claim(s) _ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *11/07/2008*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is responsive to the amendment filed on 11/07/2008.

2. The objections and rejections not addressed below are deemed withdrawn.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Claim Rejections - 35 USC § 103

4. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujita et al, JP 11-116763, in view of Kanimori et al, WO02/085985.

The rejection of claims 1-5 stands as per the reasons outlined in the previous Office Action.

5. Claim 6 was amended to place it in proper multiple dependent form, and recites that the weight of (A) is at most 50% of the total weight of (A), (B), and (C) in the curable composition of any one of claims 1 to 4.

6. Fujita discloses that the vinyl polymer having terminal cross-linkable silyl groups (component (C)) and polyether polymer having cross-linkable silyl groups (component (A)) of the composition of JP11-116763 are combined in a ratio of 100/1-1/100 (¶0046) (claim 6).

7. The composition of Kanamori comprises a vinyl polymer having cross-linkable silyl groups (component (B)), a polyoxyalkylene polymer having a cross-linkable silyl group (component (A)), and a plasticizer. The weight ratio of the vinyl polymer to polyoxyalkylene is within the range of 25/75 to 45/55 (column 2, lines 56-60), and the

amount of plasticizer is 5-150 parts by weight to 100 parts by weight of the combination of the vinyl polymer and polyoxyalkylene (Column 3, lines 4-11).

8. The examiner notes that one of ordinary skill would recognize that, based on the ratios disclosed by Fujita and Kanamori, the combination of the composition disclosed by Fujita and the composition disclosed by Kanamori would result in a third composition wherein component (A) would be incorporated at levels overlapping the recited range. The examiner therefore takes the position that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the composition disclosed by Fujita with the composition disclosed by Kanamori to produce a third composition useful as an architectural sealant wherein the amount of component (A) is 50% or less compared to the total weight of (A), (B) and (C).

Response to Arguments

9. Applicant's arguments filed 11/07/2008 have been fully considered but they are not persuasive.

10. Applicant argues that neither Fujita nor Kanamori discloses a composition comprising the three components recited in the claimed invention, that combining Fujita with Kanamori would not lead to the claimed invention, and that there would be no motivation to pick up a specific component of the composition of Kanamori to add to Fujita. Applicant further states that Fujita teaches that a composition comprising components (A) and (B) is inferior to a composition comprising components (A) and (C),

and therefore would teach away from the addition of component (B) to the disclosed composition.

11. The examiner notes that the previously presented rejection was not predicated on the assertion that it would have been obvious to substitute a (meth)acrylic polymer having a cross-linkable silyl group in a side chain for the (meth)acrylic polymer having a terminal silyl group in the composition of Fujita. Similarly, the rejection did not contend that it would have been obvious to pick one specific component from the composition of Kanamori to add to the composition of Fujita. Rather, the rejection stated that it would have been obvious to combine the composition disclosed by Fujita with the composition disclosed by Kanamori to form a third composition which could be used as an architectural sealant. The examiner therefore takes the position that applicant's argument that Fujita teaches away from compositions prepared by combining only components (A) and (B) are not germane to the rejection as it has been presented.

12. As noted in paragraph 13 of the previous Office Action, MPEP § 2144.06 [R-6] states ""It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) (citations omitted) (Claims to a process of preparing a spray-dried detergent by mixing together two conventional spray-dried detergents were held to be prima facie obvious.). See also In re Crockett, 279 F.2d 274, 126 USPQ 186 (CCPA 1960) (Claims directed to a method and material for treating cast

iron using a mixture comprising calcium carbide and magnesium oxide were held unpatentable over prior art disclosures that the aforementioned components individually promote the formation of a nodular structure in cast iron.); and Ex parte Quadranti, 25 USPQ2d 1071 (Bd. Pat. App. & Inter. 1992) (mixture of two known herbicides held prima facie obvious).

13. As stated in the previous Office Action, Fujita discloses a composition comprising polypropylene oxide having cross-linkable silyl groups (component (A)) and poly(n-butyl acrylate) having terminal cross-linkable silyl groups (component (C)) which is intended for use as a sealant in construction. Kanamori discloses a composition comprising polyoxypropylene having cross-linkable silyl groups (component (A)) and a (meth)acrylic polymer containing cross-linkable silyl groups in its side chain (component (B)) which is also intended for use as an architectural sealant. As both compositions were known in the art to be useful for the same purpose, the examiner maintains that, barring a showing of unexpected results, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the composition disclosed by Fujita with the composition disclosed by Kanamori, thereby forming a third composition comprising polypropylene oxide having cross-linkable silyl groups (component (A)), a (meth)acrylic polymer having cross-linkable silyl groups in its side chain (component (B)), and a (meth)acrylic polymer having terminal cross-linkable side groups (component (C)) which could be used as an architectural sealant.

14. Applicant further argues that the data presented in Table 2 on page 82 of the submitted specification details the unexpected results obtained in the claimed invention.

The examiner notes that the Table 2 referenced by applicant compares the skinning time after storage of the claimed composition to two comparative examples: 1) a composition comprising only components (A) and (C), and 2) a composition only comprising component (C). The examiner notes that applicant does not provide data regarding the skinning time after storage of either a composition comprising only component (B) or a composition comprising components (A) and (B); as such, the evidence does not prove that the improvement in skinning time after storage would not be observed in a composition comprising components (A) and (B). The examiner therefore takes the position that there is insufficient evidence to conclude that the cited improvement in skinning time after storage is an unexpected result of the combination of components (A), (B), and (C).

15. Furthermore, while the results may be unexpected, the examiner takes the position that the evidence presented is not commensurate in scope with the claims as currently written. The data presented in Table 2 of the submitted specification only shows that the improvement in skinning time upon storage is observed for a composition comprising 21 parts of component (A), 9 parts of component (B), and 70 parts of component (C); the cited Table does not present evidence to indicate that this result is obtained when the composition is prepared using other ratios of the three components. The examiner notes, however, that the independent claim does not recite amounts of each component which are present in the claimed composition, and therefore reads on a composition prepared by combining the three recited components in any ratio.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Lenihan whose telephone number is (571)270-5452. The examiner can normally be reached on Monday through Thursday from 7:30-5:00 PM, and on alternate Fridays from 7:30-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Irina S. Zemel/
Primary Examiner, Art Unit 1796

Jeffrey Lenihan
Examiner, Art Unit 1796

/JL/